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RESTON, VA 20191		

EXAMINER	
BENGZON, GREG C	

ART UNIT	PAPER NUMBER
2144	

NOTIFICATION DATE	DELIVERY MODE
11/05/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/035,231

Applicant(s)

YASHIKI, SATOSHI

Examiner

Greg Bengzon

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 13-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 13-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

This application has been examined. Claims 1-12 have been cancelled. Claims 13-28 are pending.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 08/20/2007 has been entered.

Priority

The effective date of the subject matter in the claims in this application is January 10, 2001.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-18, 20-25, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US Patent 6862114) in view of Matsubara et al. (US Patent 6545768).

Hayashi disclosed (re. Claim 13) a communicator configured to receive a single e-mail to which a plurality of pages of image data are attached; (Hayashi – Figure 6A-6B, Column 3 Lines 1-5, Column 16 Lines 60-65, Column 17 Lines 15-30) a memory configured to store the plurality of pages of the image data attached to the received single e-mail; (Hayashi – Column 2 Lines 55-65) a controller configured to determine whether the memory overflows during the reception of the e-mail, to stop receiving the mail when it is determined that the memory overflows due the to reception of the single e-mail, (Hayashi - Column 11 Lines 40-45) and to store, in the memory, a predetermined page of the image data attached to the mail, (Hayashi – Column 3 Lines 1-10) when the mail is re-received after the stop of receiving the mail, the predetermined page of the image data not being stored in the memory when the mail

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was previously received. (Hayashi – Figure 4B, Column 3 Lines 10-25, Column 4 Lines 20-25, Column 16 Lines 10-35)

However Hayashi did not disclose (re. Claim 13) a receiving Internet facsimile apparatus connectable to a mail server via a network; (re. Claim 13) a decoder configured to decode the plurality of pages of image data attached to the received e-mail ; and (re. Claim 13) a controller configured to determine that the predetermined page was not stored in the memory when the e-mail was previously received from the mail server, and that the predetermined page is distinct from any of the plurality of pages of the image data previously received from the mail server.

Matsubara disclosed (re. Claim 13) a receiving Internet facsimile apparatus connectable to a mail server via a network (Matsubara-Column 10 Lines 5-15); (re. Claim 13) a decoder configured to decode the plurality of pages of image data attached to the received e-mail (Matsubara – Column 12 Lines 5-10) ; (re. Claim 13) a controller configured to determine that the predetermined page was not stored in the memory when the e-mail was previously received from the mail server, and that the predetermined page is distinct from any of the plurality of pages of the image data previously received from the mail server. (Matsubara- Figure 5b, Column 9 Lines 15-20).

Hayashi and Matsubara are analogous art because they present concepts and practices regarding data transmission recovery and restart procedures. (Hayashi – Column 3 Lines 1-10, Matsubara-Column 15 Lines 1-10) At the time of the invention it would have been obvious to combine the teachings of Matsubara into the apparatus and method of Hayashi. The motivation for said combination would have been, as Matsubara suggests (Matsubara-Column 15 Lines 30-35), to distinguish email that has not been processed and offer superior operability.

Claim 27 is rejected on the same basis as Claim 13.

Hayashi-Matsubara disclosed (re. Claim 14) wherein, when it is determined that the memory overflows, the controller notifies, to a user of a transmitting apparatus, the transmitting apparatus transmitting the mail to the receiving facsimile apparatus, that the memory of the receiving Internet facsimile apparatus overflows. (Hayashi – Figure 10-11, Column 3 Lines 25-45)

Hayashi-Matsubara disclosed (re. Claim 15) a printer configured to print data, wherein, when the printer prints the plurality of the pages of the image data, (Hayashi – Column 5 Lines 20-30) the controller erases, from the memory, the plurality of the pages of the image data. (Hayashi – Column 4 Lines 40-55)

Hayashi-Matsubara disclosed (re. Claim 16) wherein the controller determines a received last page of the image data, the received last page of the image data being stored in the memory before the memory overflows, (Hayashi – Column 4 Lines 15-25, Column 12 Lines 35-40) determines that a page received after the received last page of the image data is the predetermined page of the image data, and stores the predetermined page of the image data in the memory, (Hayashi – Column 13 Lines 50-65) when the mail is re-received from the mail server after the stop of receiving the mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server.

Hayashi-Matsubara disclosed (re. Claim 17) wherein the memory stores a last page number, (Hayashi – Column 15 Lines 20-35) the last page number indicating a last page of the image data stored in the memory when the receiving the mail was stopped, and the controller determines that a page of the image data received after the page indicated by the last page number is the predetermined page of the image data, (Hayashi – Column 15 Lines 20-35) and stores the predetermined page of the image data in the memory, when the mail is re-received from the mail server after the stop of receiving the mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received (Hayashi – Column 16 Lines 10-35)

Hayashi-Matsubara disclosed (re. Claim 18) wherein the memory stores a number of pages of the image data stored in the memory when the receiving the mail

was stopped, (Hayashi – Column 15 Lines 20-35) and the controller determines the predetermined page of the image data, based on the number of the pages of the image data stored in the memory, and stores the predetermined page of the image data in the memory, (Hayashi – Column 15 Lines 20-35) when the mail is re-received after the stop of receiving the mail, the predetermined page of the image data not being stored in the memory when the mail was previously received.

Claims 20-25 are rejected on the same basis as Claims 13-18.

Hayashi-Matsubara disclosed (re. Claim 28) wherein, upon the controller determining that a received page of image data was previously received, to delete the previously received page from a reception buffer without decoding the image data of the received page. (Matsubara-Column 9 Lines 15-20, *'When the image data is already received (S32: YES), the image data is discarded from memory unit '*)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US Patent 6862114) in view of Matsubara et al. (US Patent 6545768), further in view of Yoshida et al. (US Patent 5031179), hereinafter referred to as Yoshida.

The combination of Hayashi and Matsubara disclosed a system that stores the number of pages received before a transmission failure or memory overflow condition is detected.

However the combination of Hayashi and Matsubara did not disclose (re. Claim 19 and 26) storing the file size that is received before a transmission failure or memory overflow condition and detected, and using said file size to determine required amount of re-transmission data. Hayashi makes an effort to reduce the waste of resources and improve performance for multimedia content handling and reproduction systems during cases of transmission errors by marking pages as 'complete' or 're-transmit'. (Column 2 Lines 5-10) The Examiner notes that while text documents (or pages) are relatively small in size, image files are relatively large and take longer to transmit and reproduce. Hayashi would have discovered that image files continue to grow in size as image capture technology improves, and marking pages as 'complete' would no longer provide the improved performance that Hayashi was seeking. Thus Hayashi would have been motivated to search for and implement a method for a more granular level of marking

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data as 'complete' or 're-transmit' so that even if only one half of the image page was received the system would still be able to differentiate between 'complete' and 're-transmit' portions.

Yoshida discloses a communications method for sending documents via facsimile apparatus that ascertains an amount of error data, (Yoshida – Column 19 Lines 40-45) discriminates between correctly received data and error data, (Yoshida – Column 16 Lines 35-40) and remembers number of bytes of data that have been transferred and received. (Yoshida – Column 19 Lines 40-45) Yoshida discloses of retransmitting only the error data when transmission errors are detected. (Yoshida – Column 21 Lines 60-65)

Hayashi, Matsubara and Yoshida are analogous art because they present concepts and practices regarding data transmission recovery and restart procedures. (Hayashi – Column 3 Lines 1-10, Yoshida – Column 4 Lines 25-35) At the time of the invention it would have been obvious to combine the teachings of Yoshida into the combined apparatus and method of Hayashi and Matsubara. The said combination would enable the combined apparatus and method of Hayashi and Matsubara to 1) enable a received data size memorizing section that, when the memory overflows, stores size of the received email data, and 2) read the received data size from said received data size memorizing section, then, stores the remaining email data corresponding to the size of the data after the read data size, in the memory. The

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motivation for doing so would be, as Yoshida suggests (Yoshida - Column 3 Lines 5-10), in order that the transmitter can determine whether to continue retransmitting a selected portion of data or discontinue retransmission and proceed with transmission of the next portion of data.

The combination of Hayashi, Matsubara and Yoshida disclosed (re. Claim 19) wherein the memory stores a data amount of the image data (Yoshida - Column 19 Lines 40-45, Column 23 Lines 20-25), stored in the memory when the receiving the e-mail was stopped, (Hayashi - Column 15 Lines 20-35) and the controller determines the predetermined page of the image data, based on the data amount of the image data stored in the memory, (Hayashi - Column 15 Lines 20-35) and stores the predetermined page of the image data in the memory, when the e-mail is re-received from the mail server after the stop of receiving the e-mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server. (Hayashi - Column 13 Lines 55-65)

The combination of Hayashi, Matsubara and Yoshida disclosed (re. Claim 26) storing, in the memory, a data amount of the image data (Yoshida - Column 19 Lines 40-45, Column 23 Lines 20-25), stored in the memory when the receiving the e-mail was stopped; (Hayashi - Column 15 Lines 20-35) determining the predetermined page of the image data, based on the data amount of the image data stored in the memory,

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(Hayashi – Column 15 Lines 20-35) when the e-mail is re-received from the mail server after the stop of receiving the e-mail; and storing the predetermined page of the image data in the memory, (Hayashi – Column 15 Lines 20-35) the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server. (Hayashi - Column 13 Lines 55-65)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 13-18, 20-25, 27-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US Patent 6862114) in view of Saito (US Patent 6128101).

Hayashi disclosed (re. Claim 13) a communicator configured to receive a single e-mail to which a plurality of pages of image data are attached; (Hayashi – Figure 6A-6B, Column Lines 40-45, Column 16 Lines 60-65, Column 17 Lines 15-30) a memory configured to store the plurality of pages of the image data attached to the received e-mail; (Hayashi – Column 2 Lines 55-65) a controller configured to determine whether

the memory overflows during the reception of the single e-mail, to stop receiving the mail when it is determined that the memory overflows due the to reception of the single e-mail, (Hayashi - Column 11 Lines 40-45) and to store, in the memory, a predetermined page of the image data attached to the mail, (Hayashi – Column 3 Lines 1-10) when the mail is re-received after the stop of receiving the mail, the predetermined page of the image data not being stored in the memory when the mail was previously received. (Hayashi – Figure 4B, Column 3 Lines 10-25, Column 4 Lines 20-25, Column 16 Lines 10-35)

However Hayashi did not disclose (re. Claim 13) a receiving Internet facsimile apparatus connectable to a mail server via a network; ; (re. Claim 13) a decoder configured to decode the plurality of pages of image data attached to the received e-mail (Saito – Column 3 Line 5-10) ; (re. Claim 13) a controller configured to determine that the predetermined page was not stored in the memory when the e-mail was previously received from the mail server, and that the predetermined page is distinct from any of the plurality of pages of the image data previously received from the mail server.

Saito disclosed (re. Claim 13) a receiving Internet facsimile apparatus connectable to a mail server via a network (Saito – Column 2 Lines 40-45); (re. Claim 13) a decoder configured to decode the plurality of pages of image data attached to the received e-mail ; (re. Claim 13) a controller configured to determine that the

predetermined page was not stored in the memory when the e-mail was previously received from the mail server, and that the predetermined page is distinct from any of the plurality of pages of the image data previously received from the mail server. (Saito – Column 7 Lines 5-15).

Hayashi and Saito are analogous art because they present concepts and practices regarding data transmission recovery and restart procedures. (Hayashi – Column 3 Lines 1-10, Saito – Column1 Lines 45-50) At the time of the invention it would have been obvious to combine the teachings of Saito into the apparatus and method of Hayashi. The motivation for said combination would have been, as Saito suggests (Saito – Column 1 Lines 45-50), to distinguish email that has not been processed and store said email for subsequent re-transmission, in order to overcome limitations on facsimile devices with limited storage capacity.

Claim 27 is rejected on the same basis as Claim 13.

Hayashi-Saito disclosed (re. Claim 14) wherein, when it is determined that the memory overflows, the controller notifies, to a user of a transmitting apparatus, the transmitting apparatus transmitting the mail to the receiving facsimile apparatus, that the memory of the receiving Internet facsimile apparatus overflows. (Hayashi – Figure 10-11, Column 3 Lines 25-45)

Hayashi-Saito disclosed (re. Claim 15) a printer configured to print data, wherein, when the printer prints the plurality of the pages of the image data, (Hayashi – Column 5 Lines 20-30) the controller erases, from the memory, the plurality of the pages of the image data. (Hayashi – Column 4 Lines 40-55)

Hayashi-Saito disclosed (re. Claim 16) wherein the controller determines a received last page of the image data, the received last page of the image data being stored in the memory before the memory overflows, (Hayashi – Column 4 Lines 15-25, Column 12 Lines 35-40) determines that a page received after the received last page of the image data is the predetermined page of the image data, and stores the predetermined page of the image data in the memory, (Hayashi – Column 13 Lines 50-65) when the mail is re-received from the mail server after the stop of receiving the mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server.

Hayashi-Saito disclosed (re. Claim 17) wherein the memory stores a last page number, (Hayashi – Column 15 Lines 20-35) the last page number indicating a last page of the image data stored in the memory when the receiving the mail was stopped, and the controller determines that a page of the image data received after the page indicated by the last page number is the predetermined page of the image data, (Hayashi – Column 15 Lines 20-35) and stores the predetermined page of the image data in the memory, when the mail is re-received from the mail server after the stop of

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receiving the mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received (Hayashi – Column 16 Lines 10-35)

Hayashi-Saito disclosed (re. Claim 18) wherein the memory stores a number of pages of the image data stored in the memory when the receiving the mail was stopped, (Hayashi – Column 15 Lines 20-35) and the controller determines the predetermined page of the image data, based on the number of the pages of the image data stored in the memory, and stores the predetermined page of the image data in the memory, (Hayashi – Column 15 Lines 20-35) when the mail is re-received after the stop of receiving the mail, the predetermined page of the image data not being stored in the memory when the mail was previously received.

Claims 20-25 are rejected on the same basis as Claims 13-18.

Hayashi-Saito (re. Claim 28) wherein, upon the controller determining that a received page of image data was previously received, to delete the previously received page from a reception buffer without decoding the image data of the received page. (Hayashi- Column 16 Lines 60-65)

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 19 and 26 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hayashi (US Patent 6862114) in view of Saito (US Patent 6128101), further in view of Yoshida et al. (US Patent 5031179), hereinafter referred to as Yoshida.

The combination of Hayashi and Saito disclosed a system that stores the number of pages received before a transmission failure or memory overflow condition is detected. However the combination of Hayashi and Saito did not disclose (re. Claim 19 and 26) storing the file size that is received before a transmission failure or memory overflow condition and detected, and using said file size to determine required amount of re-transmission data. Hayashi makes an effort to reduce the waste of resources and improve performance for multimedia content handling and reproduction systems during cases of transmission errors by marking pages as 'complete' or 're-transmit'. (Column 2 Lines 5-10) The Examiner notes that while text documents (or pages) are relatively small in size, image files are relatively large and take longer to transmit and reproduce. Hayashi would have discovered that image files continue to grow in size as image capture technology improves, and marking pages as 'complete' would no longer provide the improved performance that Hayashi was seeking. Thus Hayashi would have been motivated to search for and implement a method for a more granular level of marking

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data as 'complete' or 're-transmit' so that even if only one half of the image page was received the system would still be able to differentiate between 'complete' and 're-transmit' portions.

Yoshida discloses a communications method for sending documents via facsimile apparatus that ascertains an amount of error data, (Yoshida – Column 19 Lines 40-45) discriminates between correctly received data and error data, (Yoshida – Column 16 Lines 35-40) and remembers number of bytes of data that have been transferred and received. (Yoshida – Column 19 Lines 40-45) Yoshida discloses of retransmitting only the error data when transmission errors are detected. (Yoshida – Column 21 Lines 60-65)

Hayashi, Saito and Yoshida are analogous art because they present concepts and practices regarding data transmission recovery and restart procedures. (Hayashi – Column 3 Lines 1-10, Yoshida – Column 4 Lines 25-35) At the time of the invention it would have been obvious to combine the teachings of Yoshida into the combined apparatus and method of Hayashi and Saito. The said combination would enable the combined apparatus and method of Hayashi and Saito to 1) enable a received data size memorizing section that, when the memory overflows, stores size of the received email data, and 2) read the received data size from said received data size memorizing section, then stores the remaining email data corresponding to the size of the data after the read data size, in the memory. The motivation for doing so would be, as Yoshida

suggests (Yoshida - Column 3 Lines 5-10), in order that the transmitter can determine whether to continue retransmitting a selected portion of data or discontinue retransmission and proceed with transmission of the next portion of data.

The combination of Hayashi, Saito and Yoshida disclosed (re. Claim 19) wherein the memory stores a data amount of the image data (Yoshida – Column 19 Lines 40-45, Column 23 Lines 20-25), stored in the memory when the receiving the e-mail was stopped, (Hayashi – Column 15 Lines 20-35) and the controller determines the predetermined page of the image data, based on the data amount of the image data stored in the memory, (Hayashi – Column 15 Lines 20-35) and stores the predetermined page of the image data in the memory, when the e-mail is re-received from the mail server after the stop of receiving the e-mail, the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server. (Hayashi - Column 13 Lines 55-65)

The combination of Hayashi, Saito and Yoshida disclosed (re. Claim 26) storing, in the memory, a data amount of the image data. (Yoshida – Column 19 Lines 40-45, Column 23 Lines 20-25), stored in the memory when the receiving the e-mail was stopped; (Hayashi – Column 15 Lines 20-35) determining the predetermined page of the image data, based on the data amount of the image data stored in the memory, (Hayashi – Column 15 Lines 20-35) when the e-mail is re-received from the mail server

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after the stop of receiving the e-mail; and storing the predetermined page of the image data in the memory, (Hayashi – Column 15 Lines 20-35) the predetermined page of the image data not being stored in the memory when the e-mail was previously received from the mail server. (Hayashi - Column 13 Lines 55-65)

Response to Arguments

Applicant's arguments filed 08/20/2007 have been fully considered but they are not persuasive.

The Applicant presents the following argument(s) [*in italics*]:

HAYASHI does not disclose an Internet facsimile apparatus...

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The Examiner notes that Hayashi disclosed re-transmission of data due to memory overflow. Hayashi is not relied upon to disclose an Internet facsimile apparatus.

Furthermore the Examiner notes that at the time of the invention it was already well-known to adapt existing fax apparatus to use the email system and email

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documents. (see Umansky, US Patent 7142550, Column 1 Lines 30-40; See Naylor US Patent 6625642 B1)

The Applicant presents the following argument(s) [*in italics*]:

'...the Examiner's reliance on HAYASHI for a teaching of storing a predetermined page of image data attached to the mail when the mail is re-received is submitted to be in error, in particular, HAYASHI teaches storing all of the pages of retransmitted data...'

Hayashi disclosed storing the page of image data (Hayashi-Column 3 Lines 1-10) and remembering which pages were transmitted successfully. (Hayashi -Column 4 Lines 20-25)

The Examiner notes that there is no limitation or suggestion in the Claims to store only a single page of image data. On the contrary the claims explicitly state storing a plurality of pages.

Matsubara has overlapping disclosures regarding this feature.

Matsubara disclosed a memory unit for storing a control program and also storing image data of an e-mail facsimile document. (Matsubara-Column 10 Lines 10-25)

Matsubara also disclosed repetitive sending of e-mail and determining if the facsimile data has already been received (figure 5b).

Thus Matsubara disclosed (re. Claims 13 and 20) *storing in memory a predetermined page of the decoded image data attached to a re-received single e-mail.*

The Applicant presents the following argument(s) *[in italics]*:

HAYASHI fails to disclose a controller that determines whether the memory overflows due to the reception of the single e-mail, and stops receiving the single e-mail when it is determined that the memory overflows due to the reception of the single e-mail.

The combination of Hayashi-Matsubara disclosed *memory overflows due to the reception of the single e-mail.*

Matsubara disclosed where the repeat transmission of an email document is required due to a communication error (Matsubara-Column 14 Lines 25-35) which results in failed transmission.

Hayashi disclosed repeat transmission as required by memory overflow caused by a single document.

It would have been obvious to a person of ordinary skill in the art that a memory overflow condition is a form of communication error resulting in failed transmission. Thus it would have been obvious to combine the memory overflow condition handling techniques taught by Hayashi into Matsubara.

Similarly it would have been obvious to combine the teachings of Matsubara regarding bypassing previously received data into Hayashi.

The Applicant presents the following argument(s) *[in italics]*:

MATSUBARA et al. does not relate to an error induced retransmission system.

This, however, is a significant feature of the present invention.

The Examiner respectfully disagrees with the Applicant. Matsubara disclosed where the repeat transmission is required due to a communication error (Matsubara-Column 14 Lines 25-35)

The Applicant presents the following argument(s) *[in italics]*:

in MATSUBARA... memory overflow is not disclosed.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The Examiner notes that Hayashi disclosed re-transmission of data due to memory overflow. In the rejection, Matsubara is not being relied upon for detection of memory overflow and subsequent re-transmission. Rather, Matsubara is relied upon to disclose a receiving Internet facsimile apparatus connectable to a mail server via a

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network (Matsubara-Column 10 Lines 5-15); (re. Claim 13) a decoder configured to decode the plurality of pages of image data attached to the received e-mail (Matsubara – Column 12 Lines 5-10) ; (re. Claim 13) a controller (Matsubara-Column 11 Lines 20-25) configured to determine that the predetermined page was not stored in the memory when the e-mail was previously received from the mail server, and that the predetermined page is distinct from any of the plurality of pages of the image data previously received from the mail server. (Matsubara- Figure 5b, Column 9 Lines 15-20).

The Applicant presents the following argument(s) *[in italics]*:

'...the Examiner has not set forth a proper motivation for combining HAYASHI and MATSUBARA...'

The Examiner respectfully disagrees with the Applicant. The combination of Hayashi and Matsubara is obvious and appropriate in view of their common intent and disclosure with respect to 1) facilitate retransmission resulting from a prior transmission failure (Hayashi- Column 15 Lines 1-35, Matsubara-Column 15 Lines 1-35) and 2) prevent previously received data from wasting resources (Hayashi-Column 4 Lines 40-55, Matsubara-Column 9 Lines 35-40) over repetitive transmission.

The Applicant presents the following argument(s) *[in italics]*:

'...MATSUBARA et al. merely teaches that the same data is sent at the same time through two communication channels, and a receiver's facsimile apparatus discards all of the image data from the memory unit 23 when the image data is already received by the other channel.. '

The Examiner notes that the fact that the re-transmission occurs over a different channel is totally irrelevant since this fact does not any way affect the decision to bypass the previously received portion of the email.

Furthermore it would have been obvious to a person of ordinary skill in the networking art that the re-transmission process may be implemented using the same original transmission channel.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., *'re-transmission occurs over a different channel'*) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims.

The Applicant presents the following argument(s) *[in italics]*:

The "data communication apparatus" of YOSHIDA et al. is not an Internet facsimile apparatus.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The Examiner notes that Yoshida disclosed a facsimile apparatus that ascertains an amount of error data. Yoshida is not relied upon to disclose an Internet facsimile apparatus.

The Applicant presents the following argument(s) *[in italics]*:

SAITO does not relate to memory overflow but to unprintable mail.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The Examiner notes that Saito disclosed a facsimile apparatus that recognizes a portion of previously received email. Saito is not relied upon to disclose a memory overflow .

The Applicant presents the following argument(s) *[in italics]*:

SAITO does not disclose storing, in the memory, a predetermined page of the decoded image data attached to a re-received single e-mail

The Examiner respectfully disagrees with the Applicant. Saito disclosed a counter for pieces of email (Saito-Column 6 Lines 35-45, *'all pieces of mail are new incoming mail'*) , said pieces of email being equivalent to a page of an image attachment, in order to avoid repeated reception of previously received email.

The Examiner notes that the received data are stored in received data storage unit 34 of 2nd RAM 15.

The Applicant presents the following argument(s) [*in italics*]:

what renders mail unacceptable in SAITO is the format of the mail (rather than a memory overflow)

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references.

The Examiner notes that Saito disclosed a facsimile apparatus that recognizes a portion of previously received email. Saito is not relied upon to disclose a memory overflow.

Saito disclosed requiring retransmission of portions of email that were not acceptable.

Hayashi disclosed requiring retransmission of portions of a document due to memory overflow.

At the time of the invention it would have been obvious to a person of ordinary skill in the networking art that the cause for failed transmission may be of dissimilar nature. It would also be obvious to a person of ordinary skill in the art that regardless of the nature of the transmission error, Saito is able to recognize portions of previously received email. It would have been obvious to allow Saito combine the teachings of Hayashi in order to account for memory overflow errors.

Similarly it would have been obvious to combine the teachings of Saito regarding bypassing previously received data into Hayashi.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure

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relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Greg Bengzon whose telephone number is (571) 272-3944. The examiner can normally be reached on Mon. thru Fri. 8 AM - 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Vaughn can be reached on (571)272-3922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


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